

## REMARKS

Claims 1-9 are pending in this application. Claims 1-9 were rejected.

### Claims Rejections under 35 U.S.C. § 102(e)

Claims 1-6, 8, and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,337,983 to Bonta (hereinafter "Bonta"). Applicants respectfully disagree for the reasons and explanations set forth below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (Aug. 2001) (*quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (*quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987)). In addition, "the reference must be enabling and describe the applicant's invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that claims 1-6, 8, and 9 are not anticipated by Bonta for the reasons and explanations set forth below.

With respect to claim 1, Applicants respectfully submit that Bonta does teach or suggest all the limitations of claim 1. In particular, Bonta does not disclose or suggest the following element of claim 1: "transmitting the pilot strength measurement message from the mobile terminal at a second transmit power level, wherein the second transmit power level is greater than the first transmit power level".

Bonta discloses a method for handoff to a rescue channel without the use of handoff direction messages. (Abstract) Coordination of the rescue procedure at the infrastructure and mobile station is provided first by disabling the mobile transmitter followed by subsequent detection of signal loss and frame erasures at the serving cells, then by enabling the mobile transmitter followed by subsequent detection of signal by a rescue cell, and finally by enabling the rescue cell channel transmitter followed by subsequent detection and reception of signal and frames by the mobile. (Col. 2, lines 26-

38) The rescue procedure begins with the mobile attempting to transmit an emergency PSMM. If this message is received prior to starting the rescue procedure, the information from this message aids in selecting an appropriate rescue cell. (Col. 3, lines 11-18) When a rescue cell is able to lock a finger on the mobile, then that rescue cell will key its reserved channel transmitter and inform the BSC so that that rescue cell is forced into the soft handoff connection with the mobile. (Col. 3, lines 41-45)

The Office Action cites column 11, lines 17-18 as disclosing that a pilot strength measurement message is transmitted from a mobile terminal at a first transmit power level. However, at column 11, lines 17-18 the cited portion reads: "If two consecutive good forward link frames are detected (622), the mobile unit 330 must now send a PSMM (627) to the . . ." The sentence continues: ". . . infrastructure to let it know that the reserved rescue channels are not being used at this point in time." (Col. 11, lines 16-19) The cited portion makes no mention of a transmit power level for the PSMM. In addition the Office Action cites column 13, lines 44-46 as disclosing: "transmitting the pilot strength measurement message at a second transmit power level, wherein the second transmit power level is greater than the first transmit power level". At the cited portion the text reads: "In an alternate embodiment, the mobile unit 330 sends a PSMM to the infrastructure using up to its maximum transmit power." The cited portion does not disclose "transmitting the pilot strength measurement message from the mobile terminal at a second transmit power level, wherein the second transmit power level is greater than the first transmit power level." Bonta does not disclose transmitting a second PSMM at a greater transmit power level, nor does Bonta disclose incrementing the transmit power level. In fact, Bonta discloses variations in procedure that are implemented at the infrastructure depending on whether the emergency PSMM was received. (Col. 3, lines 10-40)

Because Bonta does disclose all the limitations of claim 1, Applicants submit that claim 1 is not anticipated by Bonta.

Claims 2 and 3 are allowable as depending directly from an allowable independent claim.

Claim 4 is allowable for the same reasons given above for claim 1. Applicants have noted the presence in the Office Action of the following rejection of claim 4:

"Regarding claim 4, the modified Chheda et al. discloses everything a claim 1 above. More specifically, the modified Chheda et al. disclose incrementing a transmit power level prior to receiving a hand-off direction message (see Chheda et al. col. 11 lines 3-22)". Applicants have presumed that this paragraph was inadvertently included in the Office Action because the Chheda reference is not mentioned or cited elsewhere in the Office Action. Applicants have responded to the rejection of claim 4 applying the Bonta reference.

Claims 5-7 are each allowable as depending directly or indirectly from an allowable independent claim.

Claim 8 is allowable for the reasons presented above for claim 1.

Claim 9 is allowable as depending directly from an allowable independent claim.

#### **Claim Rejections under 35 U.S.C. § 103**

Claim 7 was rejected as being unpatentable over Bonta in view of U.S. Patent 6,633,554 to Dalal (hereinafter "Dalal"). This rejection is respectfully traversed.

Applicants submit that the nonobviousness of independent claim 4 precludes a rejection of claim 7 at least indirectly depending therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to dependent claim 7.

**REQUEST FOR ALLOWANCE**

In view of the foregoing, Applicants respectfully submit that all pending claims in the present invention are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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By: Roberta A. Young  
Roberta A. Young, Reg. No. 53,818  
(858) 658-5803

QUALCOMM Incorporated  
5775 Morehouse Drive  
San Diego, California 92121  
Telephone: (858) 658-5787  
Facsimile: (858) 658-2502